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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/020,699	02/09/1998	ROBIN JOHN SLATER	7204	3553

7590

10/05/2004

MICHAEL CHAN
NCR CORPORATION LAW DEPARTMENT
INTELLECTUAL PROPERTY SECTION ECD2
101 WEST SCHANTZ AVENUE
DAYTON, OH 454790001

EXAMINER

ELMORE, REBA I

ART UNIT	PAPER NUMBER
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2187

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/020,699

Applicant(s)

PETERS ET AL.

Examiner

Reba I. Elmore

Art Unit

2187

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-12 and 19 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,13-18 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-2 and 4-20 are presented for examination.
2. The indicated allowability of claims 17 and 20 are withdrawn in view of the newly discovered deficiency in the claims. A rejection of these claims follows.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 2, 4, 5, 13-18 and 20 are rejected on the grounds that these claims are directed to nonstatutory subject matter and do not meet the definition of a “process” under 35 U.S.C. 101.

More specifically, claim 1 recites steps for *determining the validity of a transaction carried out by a user at a data processing system* and the broader scope of claims 14 and 17 recite steps of *validating the identity of a party attempting to execute a transaction...* without any mention of a data processing system. The claims are drafted in such a manner that the steps can be carried out or performed manually by a human. Claim 1 broadly reads on two individuals sitting at a data processing system, where one of the individuals has a list of security data. Claims 14 and 17 do not require the data processing system. These claims read on a conversation between two people where one person passes information written on a piece of paper to the other person. These claims fail to transform any physical subject matter, tangible

(matter) or intangible (energy), into a different state or thing and therefore, do not fall within the definition of a statutory “process” or within the meaning of “technology.” The examiner notes that although a statutory “process” under 35 U.S.C. 101 does not have to be performed by a machine, there must however be a transformation of physical subject matter from one state to another regardless of whether it is performed by a human or a machine. Here there is no transformation of physical subject matter. Claims 2, 4, 5, 13, 16, 18 and 20 depend directly or indirectly from one of claims 1, 14 and 17 and fail to correct the above noted deficiency and therefore inherit the deficiencies of claims 1, 14 and 17. Accordingly, claims 1, 2, 4, 5, 13-18 and 20 are directed to nonstatutory subject matter and do not meet the definition of a “process” under 35 U.S.C. 101.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reba I. Elmore, whose telephone number is (703) 305-9706. The examiner can normally be reached on M-TH from 7:30am to 6:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the art unit supervisor for AU 2187, Donald Sparks, can be reached for general questions concerning this application at (703) 308-1756. Additionally, the official fax phone number for the art unit is (703) 746-7239.

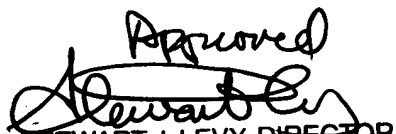
Art Unit: 2187

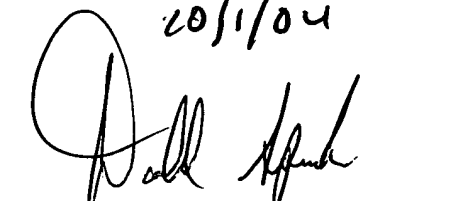
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 305-3900.

September 28, 2004



Reba I. Elmore
Primary Patent Examiner
Art Unit 2187


STEWART J. LEVY, DIRECTOR
TECHNOLOGY CENTER 2100
20/11/04


DONALD SPARKS
SUPERVISORY PATENT EXAMINER
10/1/04